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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/359,975 | 07/23/1999 | DAVID B. WEINER | UPAP-0345 | 3521 |

34137 7590 10/16/2003
COZEN O'CONNOR, P.C.
1900 MARKET STREET
PHILADELPHIA, PA 19103-3508

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| EXAMINER |
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SANDALS, WILLIAM O

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| ART UNIT | PAPER NUMBER |
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1636

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DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/359,975

Applicant(s)

WEINER ET AL.

Examiner

William Sandals

Art Unit

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 58,59,63,64,67-72, 75, 76, 84-86, 94-96 and 115-157.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

REMY YUCEL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

DETAILED ACTION

Status of the Claims

Claims 58, 59, 63, 64, 67-72, 75, 76, 84-86, 94-96 and 115-157 stand rejected under 35 U.S.C. 112, first paragraph, scope of enablement.

Claims 58, 59, 63, 64, 67-72, 75, 76, 84-86, 94-96 and 115-157 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,214,804 (Felgner et al.) in view of Price et al. and WO 91/12329 (Booth et al.).

Claims 58, 59, 63, 64, 67-72, 75, 76, 84-86, 94-96 and 115-157 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 6-14, 18-56 and 69-75 of US Patent No. 5,981,505.

Claims 58, 59, 63, 64 and 122-125 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18-24 and 30-32 of US Patent No. 5,817,637.

Claims 67-72, 75-76, 84-86, 94-96, 115-121 and 126-157 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 and 14-17 of US Patent No. 5,830,876.

Claims 67-72, 75-76, 84-86, 94-96, 115-121 and 126-157 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of US Patent No. 5,593,972.

Response to Arguments

The amendment filed July 28, 2003 requested cancellation of claims 67-72, 75, 76, 84-86, 94-96 and 126-140, and added claims 158-163. Entry of the amendment has

been denied since the amendment does not appear to move prosecution forward toward allowance or appeal.

At page 12 of the amendment filed July 28, 2003 it is asserted that the cancellation of claims 67-72, 75, 76, 84-86, 94-96 and 126-140 has avoided the scope of enablement rejection by virtue of the fact that the remaining claims no longer require protective or therapeutic immunity as a limitation of the claims.

Since the scope of enablement rejection covered all of claims 58, 59, 63, 64, 115-125 and 141-157, then the scope of enablement still applies to the now-pending claims (this rejection would apply to the newly added claims 158-165, which depend from rejected claim 149 since the newly added claims merely attempt to recapture limitations which would otherwise be lost in the cancelled claims). No amendments to the pending claims have been entered to avoid this rejection. The limitations of protective or therapeutic immunity, while not specifically claimed, must still be broadly construed to be embraced by the base claims 58, 115 and 148 and all dependent claims. Therefore, the argument is not found convincing.

The amendment filed July 28, 2003 does not address the rejection of claims 58, 59, 63, 64, 115-125 and 141-165 under 35 USC 103(a). As such the filing is considered non-responsive to this rejection.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Sandals whose telephone number is (703) 305-1982. The examiner can normally be reached on 9:30 to 6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached on (703) 305-1998. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

William Sandals


REMY YUCEL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600